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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/500,124

06/25/2004

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EXAMINER

NGUYEN, KHANH TUAN

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

07/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/500,124	Applicant(s) TAKAHASHI ET AL.	
	Examiner KHANH T. NGUYEN	Art Unit 1796	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 June 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1, 4-6, 8-18 and 20-42.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☒ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). 06/05/08 and 06/20/08
13. ☐ Other: _____.

/KTN/
06/27/2008

/Mark Kopec/
Primary Examiner, Art Unit 1796

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments filed 06/18/2008 have been fully considered but they are not persuasive. In response to Applicant's remark on pages 6 to 8, Applicant argues that Kodas reference (U.S.P.N. 6,951,666) failed to suggest the volume resistivity of an electrically conductive coating. Applicant also argues that the properties of the claimed coating such as mutually fused silver particle, specific gravity and the like are distinct structural characteristics of the composition and are not suggested by Kodas. The Examiner respectfully disagrees with the Applicant argument. In consideration of the amended claim 1, the instant claim is drawn to an electrically conductive paste and not the ending electrically conductive coating. As previously stated in the Final Office Action mailed on 03/18/2008, Kodas teaches a conductive composition comprising all the claimed ingredients (i.e. silver compound, reducing agent and dispersant) within the claimed proportions for the same utility. Therefore, the conductive composition of Kodas is capable of producing a coating having a volume resistivity, mutually fused silver particle, specific gravity and the like as claimed when heated. The court has held that structurally similar compounds are generally expected to have similar properties. In re Gvurik, 596 F. 2d 1012, 201 USPQ 552. Likewise, a composition containing similar compounds within the claimed proportions would generally be expected to have similar properties (e.g. volume resistivity, fusion property, specific gravity, viscosity and the like). For example, Kodas composition has a viscosity of at least about 1000 centipoise (10 poise) and as high as at least 5000 centipoise (500 poise) (please see lines 38-43 of column 3) that is similar to the claimed viscosity recited in claim 21. Moreover, the mere recitation of a newly discovered property (e.g. volume resistivity, fusion property, specific gravity, viscosity and the like), inherently possessed by things in the prior art does not cause a claim drawn to distinguish over the prior art. Additionally where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on." In re Swinehart, 169 USPQ 226 (CCPA 1971). Based on the above rationale, it is believed that the claimed limitations are met by the reference submitted and therefore, the rejection is maintained.

/Mark Kopec/